

**REMARKS**

In response to the Office Action mailed July 2, 2003, and the communication of June 9, 2003, each one of the cited references has been reviewed, and the rejections and objections made to the claims by the Examiner have been considered. The claims presently on file in the above-identified application are believed to be patentably distinguishable over the cited references, and therefore allowance of these claims is earnestly solicited.

Attorney for applicant acknowledges that all claims as amended in the Amendment filed on November 21, 2002 have been rejected in this final office action and that claims 1-5, 7-10, 12-32 and 34-46 are pending in the present application

In order to render the claims more clear and definite, and to place the present application in condition for immediate allowance, claims 4-5, 9-10, and 21 have been amended.

**Amended Claims**

When claim 21 was previously amended attorney for applicant over looked a typo, and more particularly the absence of the word "of" in the second element of the claim. Accordingly, claim 21 has now been amended to correct this oversight.

In a non final office action mailed August 1, 2002, the examiner indicated that claims 4, 5, 9 and 10 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant accordingly amended claims 4, 5, 9 and 10 to be independent claims that were in condition for immediate allowance. The condition of claims 4, 5, 9, and 10 has remained unchanged since being allowed in the final office action of October 29, 2002. Accordingly, the claim amendments presented in this response after a final rejection were not presented earlier as it was felt that the claims as pending earlier patentably distinguished over all prior art of record. However, since the examiner has now withdrawn allowance of claims 4, 5, 9, and 10 in the present office action mailed

July 2, 2003, attorney for applicant found it necessary to introduce the claim amendments now before the examiner. In this regard, the amendments to claims 4, 5, 9, and 10 now presented are made to make each of these claims more clear and definite to avoid rejection under 35 U.S.C. § 112, second paragraph, and to be fully supported by the application as originally filed to avoid rejection under 35 U.S.C. § 112, first paragraph. Each of the amended claims 4, 5, 9 and 10, are fully supported by the specification as originally filed, do not introduce new matter, and thus, do not raise new issues nor do they require a new search on the part of the examiner. Accordingly, amended claims 4, 5, 9 and 10 as well as their respective dependent claims are now in condition for immediate allowance and such action is earnestly requested.

### **Rejections**

#### **Rejections Under 35 U.S.C. § 112, first paragraph**

Claims 4, 5, 9, 10, 12-32 and 34-46 have been rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

**Claims 4-5:** With respect to claims 4-5, the examiner has stated that the claim defines the invention as a kit having "a decoration to be applied to said bottom surface", and that the specification as originally filed does not support this feature since the specification at page 4, lines 4-8 only provides that the bottom surface is decorated.

Attorney for applicant respectfully disagrees with the examiner on the following grounds:

The patent application as originally filed consists of the specification, the drawings, the claims and the abstract. In this regard, claim 1 as originally filed included the language to which the examiner is taking exception. More particularly, claim 1 as originally filed

to which the examiner is taking exception. More particularly, claim 1 as originally filed provided for "A novelty kit ...comprising...a decoration to be applied to said bottom surface..." The specification at page 7, lines 5-6 provide "When used on the hand, pad 10 can also be decorated with color, patterns, messages, trademarks, or advertisements." Moreover, the specification at page 4, lines 28-29 provide, "If desired, bottom surface 13 can be decorated with color, patterns, messages, trademarks, or advertising." In short then, the specification as originally filed fully supported claims 4-5, which included the original claim 1 language "a decoration to be applied to said bottom surface." Finally, in the present office action, the examiner by her own admission with respect to the rejection of claims 9-10, under 35 U.S.C. § 112, first paragraph, has stated, "The specification requires that the decoration be applied to the bottom surface." Based on the foregoing, attorney for applicant respectfully requests that the rejection of claims 4-5 under 35 U.S.C. § 112, first paragraph be withdrawn, since claims 4-5 contain subject matter, which was clearly described in such a way to reasonably convey to one skilled in the relevant art that at the time the application was filed, that the inventor had possession of the claimed invention.

**Claim 9:** With respect to claim 9, the examiner has stated "claims 9... require that the method as presently claimed provide 'decoration selected from at least one of the groups comprising color, pattern, graphic design, text, advertising, relief design and texture' in addition to a trimmable pad with adhesive with a peelable firm. The specification requires that the decoration be applied to the bottom surface of the pad. As presently claimed it could be applied to the adhesive, the second surface or the peelable film."

Responsive to this rejection, claim 9 has been amended by indicating that the decoration is provided on only the bottom surface, which step is fully supported by the specification as originally filed as discussed earlier in this Amendment.

Also with respect to claim 9, the examiner has stated "as best understood, that the pad is not only attached to a body part but to ...a pre-formed cupped protector" and that

there is no disclosure presented in the originally filed application to offer support for this feature. Attorney for applicant respectfully disagrees on the following grounds:

At page 7, lines 23 et seq. the following is provided, " Yet another embodiment of the invention is shown in FIGS. 14, 15, 16 and 17. This embodiment of the invention includes pad 60 and one of the protective shells shown in FIGS. 15, 16, or 17. ...As shown in FIG. 14, pad 60 includes a top surface 62, middle layer 65, and bottom surface 63. ...Top surface 62 is covered by a layer of adhesive. The adhesive selected should be of sufficient strength to adhere pad 60 to the elbows, knees, or shins. However, the adhesive must not be so strong as to prevent removal of pad 60 by the user when the user has finished wearing the pad. Pad 60 is optionally provided with a peel sheet 64, which protects the adhesive on top surface 62 until pad 60 is applied. Immediately prior to apply pad 60, the user removes peel sheet 64 to reveal the adhesive surface. Bottom surface 63 of pad 60 is at least partially covered with a layer of thistle clothe 66."

"Protective shells 70, 80, and 90 respectively shown in FIGS. 15, 16 and 17. As shown in FIG. 15, protective shell 70 comprises durable outer surface 71, which is shaped to fit the contour of the human knee. Protective shell 70 further includes a middle layer of impact absorbing padding 72 and inner surface 74, which is also shaped to fit the contour of the knee, Thistle clothe 73 at least partially covers inner surface 74 and engages complimentary thistle clothe 66 on bottom surface 63 of pad 60."

From the foregoing, it is clear that the protective shell 70 is attached by its inner surface 74 to the thistle clothe 66 disposed on the bottom surface 63 of pad 60 and that pad 60 is applied to a body part and secured thereto by the adhesive disposed on the top surface 62.

Based on the foregoing, it is clear that claim 9 as amended is fully supported by the specification as originally filed since the pad 60 as shown in FIG. 14 can be attached to both a body part and to a pre-formed cupped protector, such as protectors 70, 80 and 90 as shown in FIGS. 15, 16 and 17. Claim 9 has been amended to indicate "providing said pad

**Claim 10:** With respect to claim 10, the examiner has stated "claims 9 and 10 require that the method as presently claimed provide 'decoration selected from at least one of the groups comprising color, pattern, graphic design, text, advertising, relief design and texture' in addition to a trimmable pad with adhesive with a peelable firm. The specification requires that the decoration be applied to the bottom surface of the pad. As presently claimed it could be applied to the adhesive, the second surface or the peelable film."

Responsive to this rejection, claim 10 has been amended to indicate that the decoration is applied to the bottom surface. This feature is fully disclosed in the application as originally filed (See comments relative to claims 4-5 noted earlier).

Based on the foregoing, attorney for applicant respectfully requests that the rejection of claims 9-10 under 35 U.S.C. § 112, first paragraph be withdrawn, since claims 9-10 contain subject matter, which was clearly described in such a way to reasonably convey to one skilled in the relevant art that at the time the application was filed, that the inventor had possession of the claimed invention.

The examiner has stated that claims 4 and 9 are rejected under 35 U.S.C. § 112, first paragraph, because the specification, while being enabling for having a trimmable pad with hook and loop fasteners and a pre-formed cup-like protector, does not reasonably provide enablement for a trimmable pad with decorations for the pad and a pre-formed cup-like protector for use together.

As noted earlier the specification provides at page 8, line 11, "Bottom surface 63 of pad 60 is **at least partially covered** with a layer of thistle clothe 66." (emphasis added) Accordingly, there is clear support that a decoration can be applied to the bottom surface, it could be reasonably assumed that that portion of the bottom surface 63 not covered with thistle clothe could have a decoration applied thereto. In this regard, the specification does reasonably provided enablement for a trimmable pad with decorations for the pad and a pre-formed cup-like protector for use together. Based on the foregoing, attorney for applicant respectfully requests that the rejection of claims 4 and 9 under 35 U.S.C. § 112,

first paragraph be withdrawn.

Claim 23 has been rejected under 35 U.S.C. § 112, first paragraph, because the specification while being enabling for having an adhesive material, does not provide enablement for the adhesive material being non-irritating. Attorney for applicant respectfully disagrees on the following grounds:

The specification as originally filed provided at page 9, lines 4 et seq. the following:  
 " A variety of adhesives are available for adhering pads 10 and pads 60 to the body. Of the available adhesives, the adhesive used by Johnson & Johnson in its hydrocolloid adhesive Band-Aid Callus Relief product featuring Compeed ® Moisture Seal <sup>TM</sup> Technology and as disclosed in U.S. Patent No. 4,367,732; No. 4,867,748 and 5,643,187 is among the adhesives presently preferred."

U.S. Patent No. 4,367,732 at Col 5, lines 1-18 provides:

"Because of this the skin barrier according to the invention is not only suited as sealing and adhesive gasket for ostomy pouches and other ostomy closure means, but also for bandaging purposes where skin, mucous membranes or wounds are to be protected against the immediate surroundings such as intestinal, wound or glandular secretions or again bacterial attack, the action of the air, evaporation, light, impact and pressure. If the skin barrier is to be used in connection with real bandages change of these may take place without disturbing the surface of the skin or wound since the skin barrier is retained on the skin at the change, and moreover it will in itself limit bandage changes to a minimum. **The material is skin and wound friendly** and because of the elastic properties it may in many cases draw edges of wounds together and render superfluous the use of clips, which may give a less visible wound healing than would otherwise be the case."(Emphasis added).

The phrase "wound friendly" certainly would be understood by one skilled in the art to have the same meaning as "non-irritating". In addition to the foregoing, the specification At page 5, lines 11 et seq. provides, "It is desirable that the adhesive selected be waterproof as well as **compatible with skin** on the bottom of the foot." (emphasis added) In short then, the specification as originally file, would enable one skilled in the art to which the invention pertain, or with which it is most nearly connected to make and/or use the

invention commensurate in scope with claim 23. Accordingly, attorney for applicant would respectfully request that the rejection of claim 23 under 35 U.S.C. § 112, first paragraph be withdrawn.

Claims 24-32 and 34-46 have been rejected under 35 U.S.C. § 112, first paragraph as being dependent upon claims 4, 9, 10 and 23. In view of the arguments made with respect to claims 4, 9, 10 and 23 as set forth above, attorney for applicant also respectfully requests that the rejections of claims 4, 9, 10 and 23 under 35 U.S.C. § 112, first paragraph also be withdrawn.

**Rejections Under 35 U.S.C. § 112, second paragraph**

Claims 9 and 10 have been rejected under 35 U.S.C. § 112, second paragraph, as failing to set forth the subject matter which applicant regard as her invention. In this regard, the examiner has stated that in Paper No 7, filed May 20, 2002 that applicant has stated that the pad is decorated and applied directly to the wearers body, and that this statement indicates that the invention is different from what is defined in the claims because the present invention alludes to the pad having a decorated side, an adhesive side and where the adhesive side has a removable cover which can be applied to the user's body or to a separate pre-formed cupped pad or material selected from a particular group as recited in claim 10.

Responsive to this rejection, attorney for applicant has pointed out with particularly where the specification supports that the adhesive surface is utilized to attach the pad 60 to a body part, and that the thistle clothe 60 that at least partially covers the bottom surface is used to engage a pre-formed protective cup or pad, such as protective cups 70, 80, and 90. Attorney for applicant has further stated that that portion of the bottom surface of the pad not covered with thistle clothe could be available for a decoration to be applied, for

example, a bright red circle surrounding the protective cup. Based on the foregoing, and in view of the present amendments to claims 9 and 10 making them more clear and definite, the rejection under 35 U.S.C. § 112, second paragraph as noted-above has been overcome and should be withdrawn.

Claims 9 & 10 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. In this regard, the examiner has stated that claims 9 and 10, which are method claims, include language that is essentially identical except for the last phrase in each paragraph. In this regard, the examiner questions if the claims are incompletely written method claims failing to suggest that the material of the protective pad be found in the particular material or shape or that the pad be attachable not only to the wear's body, but to the particular material or shape.

**Claim 9:**

Claim 9 has been amended to make it more be more clear and definite by clarifying the step "providing said pad with pre-formed cupped pads for at least one of toes, knees, elbows and animal pads." Based on the foregoing the rejection of claim 9 under 35 U.S.C. § 112, second paragraph has been overcome and should be withdrawn.

**Claim 10:** Claim 10 has been amended to make it more clear and definite by clarifying the step "providing on said bottom surface a decoration selected from at least one of the group comprising color, pattern, graphic design, text, advertising, relief design and texture" as well as the step using a material selected from cushioning, magnetic, and gel disposed in said pad between said top surface and said bottom surface. Based on the foregoing the rejection of claim 10 under 35 U.S.C. § 112, second paragraph has been overcome and should be withdrawn.

**Rejections Under 35 USC §103**

Claims 21, 1, 3, 7, 8, 13, 15, 17, 19, 22, 2, 12, 14, 16, 18 and 20 have been rejected under 35 USC §103 as being unpatentable over *Yamanashi et al (US 6,475,585)*.

Before addressing the specifics of the present rejection, the following should be noted:

**Claim 1:** Claim 1 is a dependent claim, which depends from claim 5, which has not been rejected over the *Yamanashi et al (US 6,475,585)* reference. Accordingly, claim 1 should be allowed absence a specific rejection of claim 5 over the *Yamanashi et al (US 6,475,585)* reference.

**Claims 3, 13, 15, 17, and 19:** Claims 3, 13, 15, 17 and 19 are each dependent claims, which depend from claim 4, which has not been rejected over the *Yamanashi et al (US 6,475,585)* reference. Accordingly, claims 3, 13, 15, 17 and 19 should be allowed absence a specific rejection of claim 4 over the *Yamanashi et al (US 6,475,585)* reference.

**Claims 2, 7, 8, 12, 16, 18, and 20:** Claims 2, 7, 8, 12, 16, 18, and 20 are each dependent claims, which depend from claim 9, which has not been rejected over the *Yamanashi et al (US 6,475,585)* reference. Accordingly Claims 2, 7, 8, 12, 16, 18, and 20 should be allowed absence a specific rejection of claim 9 over the *Yamanashi et al (US 6,475,585)* reference.

Turning now to the *Yamanashi et al (US 6,475,585)* reference, the examiner has stated that the *Yamanashi et al (US 6,475,585)* reference "provides a flexible pad having an upper surface and a lower surface, with non-slip texture on the lower surface (column

16, lines 45-55: figure 4, identifier 23). The upper surface having a releasable adhesive coating and the lower surface having indicia provided thereon to decorate the pad (figure 4, identifier 25: column 16, lines 39-43) (column 17, lines 20-30). A peelable film to cover and preserve the adhesive material until used (figure 4, identifier 27: column 16, lines 43-44)." Based on the foregoing the examiner has further stated

1. "It would have been obvious to have provided the indicia on the lower surface of the pad to be any color, pattern, graphic design, text, advertising, relief design and texture as desired for end use and aesthetic appeal, since indicia is known to have many different colors, patterns, graphic designs, texts, advertising, relief designs or textures and can be selected by one having ordinary skill in the art for aesthetic purposes." Attorney for applicant respectfully disagrees with the conclusions drawn by the examiner on the following grounds:

The *Yamanashi et al (US 6,475,585)* reference is directed to an adhesive composition containing a mono functional monomer represented by a defined formula 1 and a urethane acrylate oligomer where  $n$  is an integer from 1 to 5, and  $R^1$  is a hydrocarbon residue having from 1 to 15 carbon atoms. (See claim 1 of the *Yamanashi et al (US 6,475,585)* reference). In this regard, the *Yamanashi et al (US 6,475,585)* reference teaches that this particular adhesive composition is important since "there has been a demand for a releasable adhesive element having on an obverse side thereof an image reception layer than enables an image to be formed thereon. More particularly, the *Yamanashi et al (US 6,475,585)* reference teaches, at Col. 16, lines 36 et seq. as follows:

"The mouse pad 21 includes a white substrate 22 formed in a sheet-like shape. A rough layer 23 is stacked on an obverse side of the substrate 22. A reception layer 24 is stacked on the rough layer 23. The mouse pad 21 further includes an adhesive layer 25 stacked on a reverse side of the substrate 22 as an adhesive part. The adhesive layer 25 is formed uniformly over the reverse side of the substrate 22, exclusive of a corner 26. The adhesive layer 25 is releasably covered with a release sheet 27."

The *Yamanashi et al (US 6,475,585)* reference also teaches, at Col. 8, lines 41 et seq. as follows "As shown in the sectional view of FIG. 2, the adhesive element 1 includes a white substrate 2 formed in a rectangular sheet-like shape from vinyl chloride, polyester, polycarbonate, polypropylene, or polyurethane. A primer layer 3 is stacked on an obverse of the substrate 2. A reception layer 4 is stacked on the primer layer 3. The adhesive element 1 further includes an adhesive layer 5 stacked on a reverse side of the substrate 2 as an adhesive part. The adhesive layer 5 is formed over the whole reverse side of the substrate 2, exclusive of a corner 6. The adhesive layer 5 is releasably covered with a release sheet 7. The adhesive element 1 has a thickness that allows it to be printed by a printer, e.g. an ink-jet printer." "The primary layer 3 enhances the adhesion between the substrate 2 and the reception layer 4. The primer layer 3 is formed by coating an ultraviolet-curing anchor ink containing a resin composition on the surface of the substrate 2 by screen printing or the like and then curing the coated anchor ink by ultraviolet radiation. An anchor ink usable in the present invention consists essentially of not more than 40 parts by weight of a coloring agent containing an extending pigment, from 12 to 20 parts by weight of a vinyl resin, from 18 to 30 p-arts by weight of a urethane diacrylate, from 18 to 30 parts by weight of an ether diacrylate, and from 12 to 20 parts by weight of a vinyl monomer."(Col. 8, lines 41 et seq.)

**Claim 1:** Claim 1 as previously amended provides:

"1. The novelty kit according to claim 5, wherein said pad is sufficiently flexible to conform to the contoured shape of said body parts; and wherein said body parts is selected from the group consisting of feet, hands, knees, elbows, shins, and parts thereof."

Claim 5, from which claim 1 depends provides in pertinent part amongst other things as follows:

"5. A novelty kit for providing decorative and disposable fashion wear for body parts that also protects the decorated body parts from abrasion, comprising:

a flexible, trimmable pad having a top surface and a bottom surface;  
 an adhesive material on said top surface for removably securing said pad  
 to a body part;  
 a decoration to be applied to said bottom surface;  
 a removable layer covering said adhesive material; and  
 a material selected from cushioning, magnetic material, and  
 gel disposed in said pad between said top surface and said  
 bottom surface."

Claim 5 as amended, and its dependent claim 1 as amended patentably distinguish over the *Yamanashi et al (US 6,475,585)* reference cited reference because the novel features of the present invention are not disclosed, nor suggested by the *Yamanashi et al (US 6,475,585)* reference in that the *Yamanashi et al (US 6,475,585)* reference fails to disclose or teach "a decoration to be applied to said bottom surface..." Instead, the *Yamanashi et al (US 6,475,585)* reference teaches that the adhesive element 1 includes "a white substrate 2 formed in a rectangular sheet-like shape from vinyl chloride, polyester, polycarbonate, polypropylene, or polyurethane, A primer layer is staked on an obverse side of the substrate 2. A reception layer 4 is stacked on the primer layer 3. " Col 8, lines 41-46) Then at Col 9, lines 45 et. seq. the *Yamanashi et al (US 6,475,585)* teaches, "The reception layer 4, which is provided on the primer layer 3, is a layer that receives and fixes a water-based ink outputted from a printer..." In short then, the *Yamanashi et al (US 6,475,585)* teaches the indicia is printed on the reception layer 4 not on the substrate 2. Therefore, the *Yamanashi et al (US 6,475,585)* does not disclose nor teach, "a decoration to be applied to said bottom surface."

Secondly, the *Yamanashi et al (US 6,475,585)* reference does not teach, nor suggest "wherein said pad is sufficiently flexible to conform to the contoured shape of body parts selected from the group consisting of feet, hands, knees, elbows, shins, and parts thereof." Instead, the *Yamanashi et al (US 6,475,585)* teaches, "The releasable adhesive element is usable as a mouse pad, a printed matter, etc.". There is nothing to suggest however, that the substrate 2 is "sufficiently flexible to conform to the contoured shape of

body parts selected from the group consisting of feet, hands, knees, elbows, shins, and parts thereof."

**Claim 2:** Claim 2 is a dependent claim, depending from claim 9 as amended. In this regard, claim 9 as amended provides in pertinent part:

"9. A method of decorating and protecting a body part comprising the steps of:  
furnishing a flexible pad having a top surface and a bottom surface;

providing said pad with pre-formed cupped pads for at least one of toes, knees, elbows and animal pads."

Claim 2 as previously amended, and its base claim 9 as currently amended patentably distinguish over the *Yamanashi et al (US 6,475,585)* reference because the novel features of the present invention are not disclosed, nor suggested by the *Yamanashi et al (US 6,475,585)* reference. More particularly the *Yamanashi et al (US 6,475,585)* reference fails to disclose or teach, " providing said pad with pre-formed cupped pads for at least one of toes, knees, elbows and animal pads." The *Yamanashi et al (US 6,475,585)* reference is completely silent relative to "pre-formed cupped pads."

**Claim 3:** Claim 3 is a dependent claim, depending from claim 4 as amended. Claim 4 as currently amended provides in pertinent part the following:

4. (Currently Amended) A novelty kit for providing decorative and disposable fashion wear for body parts that also protects the decorated body parts from abrasion, comprising:  
a flexible, trimmable pad having top and bottom surfaces; ...and  
providing said pad with pre-formed, cupped pads for at least one of toes, knees, elbows, and animal pads.

Claim 3 as previously amended, and its base claim 4 as currently amended patentably distinguish over the *Yamanashi et al (US 6,475,585)* reference because the novel features

of the present invention are not disclosed, nor suggested by the *Yamanashi et al (US 6,475,585)* reference. More particularly the *Yamanashi et al (US 6,475,585)* reference fails to disclose or teach, " providing said pad with pre-formed, cupped pads for at least one of toes, knees, elbows, and animal pads." The *Yamanashi et al (US 6,475,585)* reference is completely silent relative to "pre-formed cupped pads."

**Claim 7:** Claim 7 as previously amended is a dependent claim, depending from claim 9 as currently amended. Therefore claim 7 patentably distinguishes over the *Yamanashi et al (US 6,475,585)* reference under the same rationale as set forth above relative to claim 2.

Claim 7 in pertinent part provides:

"7. The method of decorating and protecting a body part according to claim 9, wherein said flexible pad is divided into a first piece adapted to be removably adhered to a heel and a second piece adapted to be removably adhered to the metatarsal region and toes."

Claim 7 as previously amended, and its base claim 9 as currently amended patentably distinguish over the *Yamanashi et al (US 6,475,585)* reference because the novel features of the present invention are not disclosed, nor suggested by the *Yamanashi et al (US 6,475,585)* reference. More particularly the *Yamanashi et al (US 6,475,585)* reference fails to disclose or teach, " wherein said flexible pad is divided into a first piece adapted to be removably adhered to a heel and a second piece adapted to be removably adhered to the metatarsal region and toes." The *Yamanashi et al (US 6,475,585)* reference is completely silent relative to this claimed feature.

**Claim 8:** Claim 8 as previously amended is a dependent claim, depending from claim 2 as previously amended. Therefore claim 8 patentably distinguishes over the *Yamanashi et al (US 6,475,585)* reference under the same rationale as set forth above with reference to claim 2.

**Claim 12:** Claim 12 as previously amended is a dependent claim, depending from claim 9 as currently amended. Therefore claim 12 patentably distinguishes over the *Yamanashi et al (US 6,475,585)* reference under the same rationale as set forth above with reference to claim 7.

Claim 12 in pertinent part provides:

"12. The method of claim 9, further comprising means for adapting said pad to apply to the feet of animal pets."

Claim 12 as previously amended, and its base claim 9 as currently amended patentably distinguish over the *Yamanashi et al (US 6,475,585)* reference because the novel features of the present invention are not disclosed, nor suggested by the *Yamanashi et al (US 6,475,585)* reference. More particularly the *Yamanashi et al (US 6,475,585)* reference fails to disclose or teach, " means for adapting said pad to apply to the feet of animal pets." The *Yamanashi et al (US 6,475,585)* reference is completely silent relative to this claimed feature.

**Claim 13:** Claim 13 as previously amended is a dependent claim, depending from claim 4 as currently amended. Therefore claim 13 patentably distinguishes over the *Yamanashi et al (US 6,475,585)* reference under the same rationale as set forth above with reference to claim 3.

Claim 13 in pertinent part provides: "

13. The fashion wear of claim 4, wherein the fashion wear is a shoe and said selected body part is the foot."

Claim 13 as previously amended, and its base claim 4 as currently amended patentably distinguish over the *Yamanashi et al (US 6,475,585)* reference because the novel features of the present invention are not disclosed, nor suggested by the *Yamanashi*

*et al (US 6,475,585)* reference. More particularly the *Yamanashi et al (US 6,475,585)* reference fails to disclose or teach, " wherein the fashion wear is a shoe and said selected body part is the foot." The *Yamanashi et al (US 6,475,585)* reference is completely silent relative to this claimed feature.

**Claim 14:** Claim 14 as previously amended is a dependent claim, depending from claim 9 as currently amended. Therefore claim 14 patentably distinguishes over the *Yamanashi et al (US 6,475,585)* reference under the same rationale as set forth above with reference to claim 7.

Claim 14 in pertinent part provides:

"14. The method of claim 9, wherein the flexible pad is a substitute for a shoe and said selected body part is the foot."

Claim 14 as previously amended, and its base claim 9 as currently amended patentably distinguish over the *Yamanashi et al (US 6,475,585)* reference because the novel features of the present invention are not disclosed, nor suggested by the *Yamanashi et al (US 6,475,585)* reference. More particularly the *Yamanashi et al (US 6,475,585)* reference fails to disclose or teach, "wherein the flexible pad is a substitute for a shoe and said selected body part is the foot." The *Yamanashi et al (US 6,475,585)* reference is completely silent relative to this claimed feature.

**Claim 15:** Claim 15 as previously amended is a dependent claim, depending from claim 4 as currently amended. Therefore claim 15 patentably distinguishes over the *Yamanashi et al (US 6,475,585)* reference under the same rationale as set forth above with reference to claim 3.

Claim 15 in pertinent part provides:

"15. The fashion wear of claim 4, wherein the fashion wear is a glove and said selected body part is the hand."

Claim 15 as previously amended, and its base claim 4 as currently amended patentably distinguish over the *Yamanashi et al (US 6,475,585)* reference because the novel features of the present invention are not disclosed, nor suggested by the *Yamanashi et al (US 6,475,585)* reference. More particularly the *Yamanashi et al (US 6,475,585)* reference fails to disclose or teach, "wherein the fashion wear is a glove and said selected body part is the hand."

**Claim 16:** Claim 16 as previously amended is a dependent claim, depending from claim 9 as currently amended. Therefore claim 16 patentably distinguishes over the *Yamanashi et al (US 6,475,585)* reference under the same rationale as set forth above with reference to claim 7.

Claim 16 in pertinent part provides:

"16. (Previously Amended) The method of claim 9, wherein the flexible pad is a substitute for a glove and said selected body part is the hand."

Claim 16 as previously amended, and its base claim 9 as currently amended patentably distinguish over the *Yamanashi et al (US 6,475,585)* reference because the novel features of the present invention are not disclosed, nor suggested by the *Yamanashi et al (US 6,475,585)* reference. More particularly the *Yamanashi et al (US 6,475,585)* reference fails to disclose or teach, "wherein the flexible pad is a substitute for a glove and said selected body part is the hand." The *Yamanashi et al (US 6,475,585)* reference is completely silent relative to this claimed feature.

**Claim 17:** Claim 17 as previously amended is a dependent claim, depending from claim 4 as currently amended. Therefore claim 13 patentably distinguishes over the *Yamanashi et al (US 6,475,585)* reference under the same rationale as set forth above with reference to claim 3.

Claim 17 in pertinent part provides: "

" 17. The fashion wear of claim 4, wherein the fashion wear is a knee pad and said selected body part is a knee."

Claim 17 as previously amended, and its base claim 4 as currently amended patentably distinguish over the *Yamanashi et al (US 6,475,585)* reference because the novel features of the present invention are not disclosed, nor suggested by the *Yamanashi et al (US 6,475,585)* reference. More particularly the *Yamanashi et al (US 6,475,585)* reference fails to disclose or teach, " wherein the fashion wear is a knee pad and said selected body part is a knee." The *Yamanashi et al (US 6,475,585)* reference is completely silent relative to this claimed feature.

**Claim 18:** Claim 18 as previously amended is a dependent claim, depending from claim 9 as currently amended. Therefore claim 18 patentably distinguishes over the *Yamanashi et al (US 6,475,585)* reference under the same rationale as set forth above with reference to claim 7.

Claim 18 in pertinent part provides:

"18.The method of claim 9, wherein the flexible pad is a substitute for a knee pad and said selected body part is the knee."

Claim 18 as previously amended, and its base claim 9 as currently amended patentably distinguish over the *Yamanashi et al (US 6,475,585)* reference because the novel features of the present invention are not disclosed, nor suggested by the *Yamanashi et al (US 6,475,585)* reference. More particularly the *Yamanashi et al (US 6,475,585)* reference fails to disclose or teach, " wherein the flexible pad is a substitute for a knee pad and said selected body part is the knee." The *Yamanashi et al (US 6,475,585)* reference is completely silent relative to this claimed feature.

**Claim 19:** Claim 19 as previously amended is a dependent claim, depending from claim 4 as currently amended. Therefore claim 19 patentably distinguishes over the *Yamanashi et al (US 6,475,585)* reference under the same rationale as set forth above with reference to claim 3.

Claim 19 in pertinent part provides:

"19. The fashion wear of claim 4, wherein the fashion wear is an elbow pad and said selected body part is an elbow."

Claim 19 as previously amended, and its base claim 4 as currently amended patentably distinguish over the *Yamanashi et al (US 6,475,585)* reference because the novel features of the present invention are not disclosed, nor suggested by the *Yamanashi et al (US 6,475,585)* reference. More particularly the *Yamanashi et al (US 6,475,585)* reference fails to disclose or teach, "wherein the fashion wear is an elbow pad and said selected body part is an elbow."

**Claim 20:** Claim 20 as previously amended is a dependent claim, depending from claim 9 as currently amended. Therefore claim 18 patentably distinguishes over the *Yamanashi et al (US 6,475,585)* reference under the same rationale as set forth above with reference to claim 7.

Claim 20 in pertinent part provides:

"20. The method of claim 9, wherein the flexible pad is a substitute for an elbow pad and said selected body part is an elbow."

Claim 20 as previously amended, and its base claim 9 as currently amended patentably distinguish over the *Yamanashi et al (US 6,475,585)* reference because the novel features of the present invention are not disclosed, nor suggested by the *Yamanashi et al (US 6,475,585)* reference. More particularly the *Yamanashi et al (US 6,475,585)*

reference fails to disclose or teach, "wherein the flexible pad is a substitute for an elbow pad and said selected body part is an elbow." The *Yamanashi et al (US 6,475,585)* reference is completely silent relative to this claimed feature.

**Claim 21:** Claim 21 provides in pertinent part:

"21. (Previously amended) A novelty fashion wear item, comprising:

a flexible pad having an upper surface and a lower surface with a non-slip texture;

said pad being sufficiently flexible to conform to a contoured surface area of a body part;

said pad having its entire upper surface coated with an adhesive material for removably securing said pad to said contoured surface area of a body part to facilitate decorating said contoured surface area; and

said pad having its lower surface provided with indicia to decorate said contoured surface area.

Claim 21 as currently amended, patentably distinguish over the *Yamanashi et al (US 6,475,585)* reference because the novel features of the present invention are not disclosed, nor suggested by the *Yamanashi et al (US 6,475,585) reference*. More particularly the *Yamanashi et al (US 6,475,585) reference* fails to disclose or teach, " said pad having its lower surface provided with indicia to decorate said contoured surface area." Instead, the *Yamanashi et al (US 6,475,585) reference* teaches that the lower surface of the substrate 22 is coated with a primer layer 3 that enhances the adhesion between the substrate 2 and the reception layer 4. (See Col. 8, lines 55 et seq.).

**Claim 22:** Claim 22 provides in pertinent part:

"22. A method of decorating a body part, comprising the steps of:

providing decorative fashion wear;

said fashion wear including:

a flexible pad with a non-slip texture, said pad having an upper surface and a lower surface and being sufficiently flexible to conform to a contoured surface area of the body part;

providing the entire upper surface with an adhesive material for removably securing said pad to the contoured surface area of the body part;

providing the lower surface with indicia to decorate the contoured surface area of the body part; and

applying said decorative fashion wear to the contoured surface area of the body part for decorating purposes."

Claim 22 as previously amended, patentably distinguish over the *Yamanashi et al.* (US 6,475,585) reference because the novel features of the present invention are not disclosed, nor suggested by the *Yamanashi et al.* (US 6,475,585) reference. More particularly the *Yamanashi et al.* (US 6,475,585) reference fails to disclose or teach, providing decorative fashion wear..." Instead, the *Yamanashi et al.* (US 6,475,585) reference teaches an adhesive element. There is nothing in the *Yamanashi et al.* (US 6,475,585) reference that would suggest that the adhesive element 1 would be suitable for use as fashion wear.

Secondly, the *Yamanashi et al.* (US 6,475,585) reference fails to teach or disclose " providing the lower surface with indicia to decorate the contoured surface area of the body part..." Instead the *Yamanashi et al.* (US 6,475,585) teaches that the lower surface of the substrate 22 is coated with a primer layer 3 that enhances the adhesion between the substrate 2 and the reception layer 4. (See Col. 8, lines 55 et seq.). Finally, the *Yamanashi et al.* (US 6,475,585) reference fails to disclose or teach, " applying said decorative fashion wear to the contoured surface area of the body part for decorating purposes."

**Claim 23:** Claim 22 provides in pertinent part:

"23. A fashion wear item, comprising:

a non-slip pad having a non-skin irritating adhesive material completely covering one of its surfaces and decorative indicia covering at least a portion of another one of its surfaces; and

a peelable material covering said non-skin irritating adhesive to protect the adhesive material until it is ready for use to facilitating decorating a contoured area of a user selected body part. "

Claim 23 as previously amended, patentably distinguish over the *Yamanashi et al* (US 6,475,585) reference because the novel features of the present invention are not disclosed, nor suggested by the *Yamanashi et al* (US 6,475,585 reference. More particularly the *Yamanashi et al* (US 6,475,585 reference fails to disclose or teach, " a non-slip pad having a non-skin irritating adhesive material completely covering one of its surfaces and decorative indicia covering at least a portion of another one of its surfaces" Instead, the *Yamanashi et al* (US 6,475,585 reference teaches at Col. 8, lines 49 et seq. "The adhesive layer 5 is formed over the whole reverse side of the substrate 2, **exclusive of a corner 6.**" Moreover, there is nothing in the *Yamanashi et al* (US 6,475,585 reference that teaches that the adhesive layer 5 is " a non-skin irritating adhesive material "

Finally, the *Yamanashi et al* (US 6,475,585) reference fails to teach or disclose " decorative indicia covering at least a portion of another one of its surfaces..." Instead the *Yamanashi et al* (US 6,475,585) teaches that the lower surface of the substrate 22 is coated with a primer layer 3 that enhances the adhesion between the substrate 2 and the reception layer 4. (See Col. 8, lines 55 et seq.). Therefore, the *Yamanashi et al* (US 6,475,585 reference fails to disclose or suggest "decorative indica covering at least a portion of another one of its surfaces..."

Thus, while the *Yamanashi et al* (US 6,475,585) reference may teach a sheet of material with an adhesive surface that will allow the sheet to be attached to a window glass

or the top of a desk (See Col. 4, lines 36-44), the *Yamanashi et al (US 6,475,585)* reference does not disclose, nor suggest, the novel features and steps of the present invention as claimed. Clearly, there is nothing in the *Yamanashi et al (US 6,475,585)* reference that would suggest that a mouse pad or a sheet of paper would be suitable to be worn by an individual as fashion wear or would be sufficiently flexible to conform to a contoured surface area of a body part.

### **Conclusion**

Attorney for Applicant has carefully reviewed each one of the cited references made of record and not relied upon, and believes that the claims presently on file in the subject application patentably distinguish thereover, either taken alone or in combination with one another.

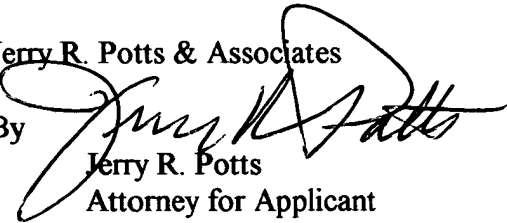
Therefore, all claims presently on file in the subject application are in condition for immediate allowance, and such action is respectfully requested. If it is felt for any reason that direct communication with Applicant's attorney would serve to advance prosecution of this case to finality, the Examiner is invited to call the undersigned Jerry R. Potts, Esq. at the below-listed telephone number.

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respectfully submitted,

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